

**REMARKS/ARGUMENTS**

Claims 47-57 are pending in this application. The Examiner has rejected claims 47-57 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. Specifically, the Examiner has rejected claim 47 for including a broad limitation followed by a narrow limitation. In response, Applicant has deleted the phrase "in particular sausage" from the preamble of claim 47. Applicant believes this amendment overcomes the Examiner's rejection.

Additionally, the Examiner has rejected claim 57 under 35 U.S.C. § 112 for being indefinite and under 35 U.S.C. § 101 for being an improper definition of a process. In response, Applicant has amended claim 57 to place the claim in proper format, thereby overcoming the Examiner's rejection.

The Examiner has rejected claims 47, 48 and 52-55 under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 99/13729 in view of International Publication N1. WO 93/12660. Applicant respectfully traverses the rejection.

An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 U.S.P.Q.2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider

the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 277 U.S.P.Q. 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often

comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 U.S.P.Q.2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All the obvious rejections asserted by the Examiner are based on a combination of prior art references, e.g. the liquid smoke coagulation treatment of WO 99/13729 combined with the collagen and pre-coagulation treatment of WO 93/12660. To justify this combination the Examiner stated "[i]t would have been obvious to one of ordinary skill in the art to incorporate the collagen and pre-treatment of WO 93/12660 into the invention of WO 99/13729 since both are directed to sausage making." While the Examiner's statement may identify the relevant art, i.e. sausage making, this rationale fails to identify the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (recognizing that the combination of the references taught every element of the claimed invention; however, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper).

To the contrary, the Examiner's decision is based on a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. Yet this reference-by-reference, limitation-by-limitation analysis fails

to demonstrate how the WO 93/12660 reference teaches or suggests its combination with WO 99/13729 to yield the claimed invention. For example, the Examiner has not explained why, if it was obvious to make the proposed combination, that the co-extruded food product of WO 99/13729 (1999) did not combine the collagen and pre-coagulation treatment of WO 93/12660 (1993) when these options were readily available. Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, the Examiner's rejection based on obviousness should be withdrawn.

Even if there was some objective motivation to combine the references as suggested by the Examiner, the apparatus that would result still would not meet the limitations of independent claim 47. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. In other words, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

Claim 47 requires, in part,

- a. co-extruding a continuous string of a food product which is provided all around with a substantially uniform collagen layer;
- b. **subjecting the collagen layer to a coagulating treatment** under the influence of coagulants, whereafter the final co-extruded food product is obtained; and
- c. separating the string of food product into **separate units before subjecting these to the coagulation treatment.**

(emphasis added).

In proposing the combination of WO 93/12660 with WO 99/13729, the Examiner has overlooked that claim 47 requires two coagulation treatments. First, claim 47 requires subjecting the collagen layer to a coagulation treatment prior to separating the string of food product into separate units. (Specification, page 12, line 30 through page 13, line 8). Second, claim 47 requires subjecting the separate units to a coagulation treatment after separating the string of food product into separate units. (Specification, page 13, lines 15-20).

By contrast, WO 93/12660 only teaches subjecting the collagen to a coagulation treatment prior to separating the string of food product into separate units. (page 4, line 2 through page 5, line 14). WO 93/12660 fails to teach subjecting the separate units to a coagulation treatment after separating the string of food product into separate units.

WO 99/13729, on the other hand, fails to teach any sort of coagulation treatment within the meaning commonly understood in the art. The Examiner has asserted that WO 99/13729 teaches subjecting the separate units to a liquid smoke coagulation treatment. This is incorrect. While WO 99/13729 states that the individual sausages may be treated with smoke liquid (page 12, lines 34-37), it is important to note that the sausages are smoked for "taste-improving" qualities, and not to dry and solidify the collagen layer. As stated in Applicant's specification, the separate units are treated to a coagulation treatment to remove water from the collagen layer such that the collagen dries and solidifies. (page 13, lines 20-21). This is consistent with the definition of "coagulation" advanced by WO 93/12660, which states that coagulation "refers to the step involving hardening and stabilisation of the casing". (page 3,

lines 16-17). Additionally, WO 93/12660 states that coagulation is achieved "firstly by removal of water from the collagen gel, and secondly by cross-linking the collagen." (page 3, lines 18-20). The brief discussion of good tasting smoked sausages in WO 99/13729 fails to teach coagulation within this meaning.

Thus, the method that would result from the Examiner's proposed combination does not meet the terms of independent claim 47. The combination that would result would subject only the collagen layer to a coagulation treatment, and not the separate units after separating the food product into separate units, as required by claim 47. The Examiner may not use Applicant's claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. See In re Fitch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). The only way to arrive at the method proposed by the Examiner is to rely upon hindsight, in view of the application. The Federal Circuit has held that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Therefore, as the combination of prior art references does not result in the invention as claimed, and the combination proposed by the Examiner can only be achieved through hindsight, the obvious rejection should be withdrawn.

#### **CONCLUSION**

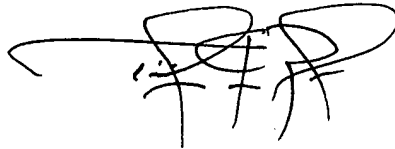
In view of the above amendments and remarks, Applicant believes claims 47-57 are in condition for allowance and respectfully requests allowance of such claims. If any issues remain that may be expeditiously addressed in a telephone

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interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "TJZ", with a large, stylized flourish extending to the left.

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